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EXAMINER

BAUM, RONALD

ART UNIT PAPER NUMBER

2136

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/876,217

Applicant(s)

MANKEFORS, STEFAN

Examiner

Ronald Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) • | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . • | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-28 are pending for examination.
2. Claims 1-28 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Joshi, U.S.

Patent 4,688,169.

4. As per claim 1; "A method for preventing unauthorized reproduction of first data on a computer having second data provided as Operating System instruction and data, the method comprises the steps of [col. 1, lines 25-col. 10, line 50, whereas the prevention of unauthorized execution of a (software) program is broadly interpreted by the examiner to encompass the execution of the installation software inherent in the installation of digital content (data, instructions, etc.,) involved with the prevention of 'unauthorized reproduction of first data on a computer ...' (you can't reproduce computer data on the computer per se if the data is not loaded onto / into the computer memory, and it is loaded via an installation (i.e., software program instructions) means), or, upon execution prevented via erasure of said application program upon incorrect verification (i.e., col. 8, lines 8-58, col. 3, lines 44-64).]: generating control data wherein said control data is generated by means of third data which is separate from said second data

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[i.e., figures 8-10 and accompanying descriptions, whereas the ‘machine identification code’ entered / stored on the computer is broadly interpreted by the examiner to encompass the ‘control data wherein said control data is generated by means of third data’]; manipulating said second data by inserting said control data within a portion of said second data when installing said first data onto the computer [i.e., figures 8-10 and accompanying descriptions, whereas the ‘insert code in program ...’ on the computer is broadly interpreted by the examiner to encompass the ‘inserting said control data within a portion of said second data when *installing* said first data onto the computer’].”;

Further, as per claim 19; “An article of manufacture comprising: a computer-usable medium having a computer-readable program code and means embodied therein [This claim is the embodied means plus function software claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection] for preventing unauthorized reproduction of first data on a computer having second data provided as Operating System instruction and data and a method for generating control data, wherein said control data is generated by means of third data being separate from said second data, and said second data being manipulated by inserting said control data within a portion of said second data when installing said first data on said computer.”;

Further, as per claim 20; “A computer data signal embodied in a carrier wave comprising first data [This claim is the embodied ‘downloadable’ software claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection], for preventing unauthorized reproduction of first data on a computer having second data provided as Operating System instruction and data and a method for generating control data, wherein said control data

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is generated by means of third data being separate from said second data, and said second data is manipulated by inserting said control data within a portion of said second data when installing said first data on said computer.”;

Further, as per claim 21; “In a computer provided with an operative system, a computer program product for use with an executable computer program, said computer program product comprising [This claim is the embodied software claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection]: an instruction set for preventing unauthorized reproduction of first data, said computer being provided with second data provided as Operating System instruction and data and the method comprising a step of generating control data, wherein said control data is generated by means of third data being separate from said second data, and said second data is manipulated by inserting said control data within a portion of said second data when installing said first data. ”;

Further, as per claim 28; “A computer unit [This claim is the system (apparatus) claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection] comprising memory unit, input/output units and a mass storage unit, on which an operating system file is provided for controlling functions of said computer unit, and programs for running application on said computer unit, wherein it further comprises a set of instruction codes for preventing unauthorized reproduction of at least one of said programs running application on said computer unit, through generating control data, and storing said control data within a portion of second data being part of said operating system of said computer, when installing said applications.”.

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5. Claim 2 *additionally recites* the limitation that; “The method of claim 1 wherein said control data is generated using computer hardware information.”. The teachings of Joshi suggest such limitations (i.e., col. 2, lines 46-64, col. 3, lines 31-43, col. 4, lines 24-34, col. 5, lines 26-53, figure 2, items labeled 38-49; the computer ID circuit example.).

6. Claim 3 *additionally recites* the limitation that; “The method of claim 1 wherein said control data is generated using data received from a provider of said first data.”. The teachings of Joshi suggest such limitations (i.e., col. 6, lines 39-58, figure 10 and associated descriptions.).

7. Claim 4 *additionally recites* the limitation that; “The method of claim 3 wherein said data received from the provider is non-recurrent.”. The teachings of Joshi suggest such limitations (i.e., col. 6, lines 39-58, col. 7, lines 54-68, col. 9, lines 29-col. 10, line 21, figure 10 and associated descriptions.).

8. Claim 5 *additionally recites* the limitation that; “The method of claim 2 wherein said computer hardware information comprises one or more of a component identity, program execution time, program installation time, number of files on a hard disk of said computer, size of hard disk and/or pointer device position.”. The teachings of Joshi suggest such limitations (i.e., col. 2, lines 46-64, col. 3, lines 31-43, col. 4, lines 24-34, col. 5, lines 26-53, figure 2, items labeled 38-49; the computer ID circuit example.).

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9. Claim 6 *additionally recites* the limitation that; “The method according to claim 1, comprising a control sequence further comprising the steps of generating control data and comparing control data to said data stored within said portion of said second data being part of said operating system.”. The teachings of Joshi suggest such limitations (i.e., col. 2, lines 65-col. 3, line 63, col. 8, lines 8-52, col. 9, lines 29-col. 10, line 50).

10. As per claim 7; “A method of preventing unauthorized reproduction of data on a computer having an Operating System, said method comprising the steps of [col. 1, lines 25-col. 10, line 50, whereas the prevention of unauthorized execution of a (software) program is broadly interpreted by the examiner to encompass the execution of the installation software inherent in the installation of digital content (data, instructions, etc.,) involved with the prevention of ‘unauthorized reproduction of first data on a computer ...’ (you can’t reproduce computer data on the computer per se if the data is not loaded onto / into the computer memory, and it is loaded via an installation (i.e., software program instructions) means), or, upon execution prevented via erasure of said application program upon incorrect verification (i.e., col. 8, lines 8-58, col. 3, lines 44-64).]; providing an instruction set being separate from said operating system [i.e., figures 8-10 and accompanying descriptions, whereas the ‘machine identification code’ entered / stored on the computer is broadly interpreted by the examiner to encompass the ‘control data wherein said control data is generated by means of third data’]; acquiring hardware-based information using a first control which includes a computer hardware control [i.e., col. 2, lines 46-64, col. 3, lines 31-43, col. 4, lines 24-34, col. 5, lines 26-53, figure 2, items labeled 38-49; the computer ID circuit example.]; comparing said acquired information with previously stored information [i.e., col.

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2,lines 65-col. 3,line 63, col. 5,lines 65-col. 8,line 52, col. 9,lines 29-col. 10,line 50]; when said comparison indicates that the hardware information is not changed, acquiring a hardware-based configuration [col. 5,lines 65-col. 8,line 52, col. 9,lines 29-col. 10,line 50, whereas clearly if the execution doesn't cease, or the application is not erased, or the execution is not in an infinite loop, this is an indication the 'hardware information is not changed', given the verification can occur during execution / installation / boot time.]; generating at least one unique location for a security resource within a portion of said Operating System, based on a hardware identity and / or hardware configuration [figures 2-10 and accompanying descriptions, particularly figures 3-4]; controlling the presence of said resource and, in case the resource is present, performing a self consistency inspection [figures 2-10 and accompanying descriptions, particularly figures 3-4]; in case of a positive inspection result, generating a new unique location [figures 2-10 and accompanying descriptions, particularly figures 3-4]; performing a search for controlling pre-installations in this new unique location and performing a self-consistency [figures 2-10 and accompanying descriptions, particularly figures 3-4]; and in case of self-consistency, processing said data [figures 2-10 and accompanying descriptions, particularly figures 3-4].”.

11. Claim 8 *additionally recites* the limitation that; “The method according to claim 7 wherein said computer hardware control comprises acquiring a serial or part number of a machine part.”. The teachings of Joshi suggest such limitations (i.e., col. 2,lines 46-64, col. 3,lines 31-43, col. 4,lines 24-34, col. 5,lines 26-53, figure 2, items labeled 38-49; the computer ID circuit example.).

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12. Claim 9 *additionally recites* the limitation that; “The method according to claim 7 wherein said hardware identifier is used to initialize a random-number generator, which generates one or several random locations within said Operating System file, based on the input information.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col. 7, line 33, whereas the use of “a smaller piece of the information [machine ID] ... [and] scrambled [‘initialize a random-number generator’]... or later encoded ...” is broadly interpreted by the examiner to encompass the ‘initialize a random-number generator’ claim limitation.).

13. Claim 10 *additionally recites* the limitation that; “The method according to claim 9 wherein said locations are always the same as long as the initializing numbers are the same.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col. 7, line 33, whereas the use of “a smaller piece of the information [machine ID] ... [and] scrambled [‘initialize a random-number generator’ that by virtue of it being a pseudo-random number generator (inherent aspect of computer generated ‘random numbers’)]... or later encoded ...” is broadly interpreted by the examiner to encompass the ‘locations are always the same as long as the initializing numbers are the same’ claim limitation.).

14. Claim 11 *additionally recites* the limitation that; “The method according to claim 7 wherein said resource includes a flag and a correctly stored address of the flags or identity.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col. 7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

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15. Claim 12 *additionally recites* the limitation that; “The method according to claim 7 wherein said self-consistency inspection includes inspection of time of installation of program and/or additional random numbers.”. The teachings of Joshi suggest such limitations (i.e., col. 3, lines 7-64, col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

16. Claim 13 *additionally recites* the limitation that; “The method according to claim 7 wherein the location is unique both with respect to the hardware based information and also the program installation time.”. The teachings of Joshi suggest such limitations (i.e., col. 2, lines 11-24, col. 3, lines 7-64, col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4, whereas the use of “a smaller piece of the information [machine ID] ... [and] scrambled [‘location is unique both with respect to the hardware based information and also the program installation time’]... or later encoded ...” that by virtue of ‘when’ the installation occurs clearly changes the dynamics of the memory loading of executable software that in the case of the order of DLL type library file loading is broadly interpreted by the examiner to encompass the ‘location is unique both with respect to the hardware based information and also the program installation time’ claim limitation.).

17. Claim 14 *additionally recites* the limitation that; “The method according to claim 7 wherein in absence of a resource, determining the presence of a first resource and installing the first resource if the determination indicates the absence of the first resource.”. The teachings of

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Joshi suggest such limitations (i.e., col. 5, lines 39-col. 7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

18. Claim 15 *additionally recites* the limitation that; “The method according to claim 7 wherein if a first resource is present, determining if the method is in an installation mode and if the self consistency exists, if the determination determines a negative, stopping the processing of said data.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col. 7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

19. Claim 16 *additionally recites* the limitation that; “The method according to claim 7 wherein in case of operation in installation mode, prompting an operator for a code key obtained from a supplier of said set of data.”. The teachings of Joshi suggest such limitations (i.e., col. 6, lines 39-58, figure 10 and associated descriptions.).

20. Claim 17 *additionally recites* the limitation that; “The method according to claim 16 wherein if a correct code key is entered and is consistent, the control is approved and said data is processed.”. The teachings of Joshi suggest such limitations (i.e., col. 4, lines 24-col. 5, line 25, col. 5, lines 65-col. 7, line 33.).

21. As per claim 18; “A method for purchasing and securing software in a system comprising a customer computer, a server, a database and a key server, the method comprising the steps of: purchasing or downloading software by a customer [col. 1, lines 25-col. 10, line 50, whereas the

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securing of software is broadly interpreted by the examiner to encompass the execution of the installation software inherent in the installation of digital content (data, instructions, etc.,) involved with the 'securing software in a system comprising a customer computer, a server, a database and a key server' (you can't reproduce computer data on the computer per se if the data is not loaded onto / into the computer memory, and it is loaded via an installation (i.e., software program instructions) means), or, upon execution prevented via erasure of said application program upon incorrect verification (i.e., col. 8, lines 8-58, col. 3, lines 44-64), in either case, said Joshi teachings software is clearly distributed (i.e., see claim 20 rejection above) via a network (i.e., 'a server, a database and a key server'.); installing said software on said customer computer and registering said software; registering said software having a unique code in said database, using a copy protection system on said customer computer [i.e., col. 2, lines 12-64]; and communicating using said installed software with the database for unlocking said software.".

24. Claim 23 *additionally recites* the limitation that; "The system according to claim 21 wherein said instruction set is a compiled program code.". The teachings of Joshi suggest such limitations (i.e., col. 2, lines 65-col. 3, line 13, (whereas PROM based executable code (i.e., embedded controller applications) are inherently compiled in the broader sense, and at the very least in an assembled object / executable form prior to programming onto a PROM), col. 4, lines 24-col. 6, line 19, whereas the 'infinite loop' programmed in C is clearly compiled.).

25. Claim 24 *additionally recites* the limitation that; "The system according to claim 21 wherein said instruction set integrated with said data on a computer is modified with respect to

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hardware information and requiring a first code key from said system in return for an identity code.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

26. Claim 25 *additionally recites* the limitation that; “The system according to claim 23 wherein said identity code comprises one or more of hardware identity, installation-based information or a unique identifier.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

27. Claim 26 *additionally recites* the limitation that; “The system according to claim 21 wherein it provides a key of a first type when installing a first set of data, which allows installation of the program.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

28. Claim 27 *additionally recites* the limitation that; “The system according to claim 21 wherein it provides said developer/distributor with a key of second type, which allows producing and/or distributing keys of first type specific for the instruction set of the developer / distributor.”. The teachings of Joshi suggest such limitations (i.e., col. 5, lines 39-col.7, line 33, figures 2-10 and accompanying descriptions, particularly figures 3-4.).

29. As per claim 22; “A system for managing a security code distribution for preventing unauthorized reproduction of first data, the system being established as a partnership, each

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partner being one of a plurality of users of said first data, or distributors and/or developers of the same, comprising [col. 1, lines 25-col. 10, line 50, whereas the prevention of unauthorized execution of a (software) program is broadly interpreted by the examiner to encompass the execution of the installation software inherent in the installation of digital content (data, instructions, etc.,) involved with the prevention of 'unauthorized reproduction of first data on a computer ...' (you can't reproduce computer data on the computer per se if the data is not loaded onto / into the computer memory, and it is loaded via an installation (i.e., software program instructions) means), or, upon execution prevented via erasure of said application program upon incorrect verification (i.e., col. 8, lines 8-58, col. 3, lines 44-64). Further, the vendor / developer clearly had to have a means / method (and implementation means / apparatus) to create / transfer to the destination (i.e., customer(s)) computer such that the protection of the application program can be effected (i.e., col. 5, lines 65-col. 8, line 7).]: a computer processor means for processing first data [i.e., figures 1-10 and accompanying descriptions]; storage means for storing first data on a storage medium [i.e., figures 1-10 and accompanying descriptions]; first means for initializing the storage medium [i.e., figures 1-10 and accompanying descriptions, whereas at the application and operating system level (at install / update, etc.,) clearly has the storage medium initialized (i.e., DOS partitioning, formatting, etc.,).]; second means for generating an instruction set to be delivered to at least one of said distributors and/or developers for integration with said first data, said instruction set being provided for generating control data for preventing unauthorized reproduction of said first data [col. 1, lines 25-col. 10, line 50, whereas the vendor / developer clearly had to have a means / method (and implementation means / apparatus) to create / transfer to the destination (i.e., customer(s)) computer such that the protection of the application

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program can be effected (i.e., col. 5, lines 65-col. 8, line 7).]; third means for storing said instruction set on said storage medium; and fourth means for making said instruction set on said storage medium available for distribution to one of said distributors and/or developers on demand [col. 1, lines 25-col. 10, line 50, whereas the vendor / developer clearly had to have a means / method (and implementation means / apparatus) to create / transfer to the destination (i.e., customer(s)) computer such that the protection of the application program can be effected (i.e., col. 5, lines 65-col. 8, line 7).].”.

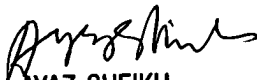
Conclusion

30. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (703) 305-4276. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The Fax number for the organization where this application is assigned is 703-872-9306.

Ronald Baum

Patent Examiner


AYAZ SHEIKH
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